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09/688,006	10/13/2000	Elizabeth Sisley	1142.001US1	9173
21186 7590 07/09/2008 SCHWEGMAN, LUNDBERG & WOESSNER, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402				
EXAMINER				
DAY, HERNG DER				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/688,006

**Applicant(s)**

SISLEY, ELIZABETH

**Examiner**

HERNG-DER DAY

**Art Unit**

2128

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-11 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-11 and 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This communication is in response to Applicant's Amendment and Response ("Amendment") to Office Action dated November 7, 2007, filed May 7, 2008.
- 1-1. Claims 1, 9, 14, and 15 have been amended. Claims 1-3, 5-11, and 13-16 are pending.
- 1-2. Claims 1-3, 5-11, and 13-16 have been examined and rejected.

#### ***Drawings***

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings on the file is informal. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

#### ***Specification***

3. The amendment filed November 24, 2006, is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The amendments to Table 6 at page 21 of the specification as shown at page 2 of the Amendment filed November 24, 2006.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Objections***

4. Claim 1 is objected to because of the following informalities. Appropriate correction is required.
- 4-1. Claim 1 recites the limitation, “said couplings including at least *on* coupling from each of control couplings, data couplings and peripheral couplings” in lines 5-6 of the claim. It appears that the “at least *on* coupling”, should be “at least *one* coupling”.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 1-3, 5-11, and 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- 6-1. Claim 1 recites the limitation “the preallocated data and code partitions” in line 10 of the claim. There is insufficient antecedent basis for this limitation in the claim.
- 6-2. Claim 9 recites the limitation “the preallocated data and code partitions” in line 12 of the claim. There is insufficient antecedent basis for this limitation in the claim.
- 6-3. Claims not specifically rejected above are rejected as being dependent on a rejected claim.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-3 and 5-8 are rejected under 35 U.S.C. 101 because the inventions as disclosed in claims are directed to non-statutory subject matter.

**8-1.** Claims 1-3 and 5-8 are directed to a computerized method for determining an allocation of software and data components in a distributed system. This claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since it fails to produce a useful, concrete, and tangible result.

As stated in the MPEP 2106 IV, “Likewise, a claim that can be read so broadly as to include statutory and nonstatutory subject matter must be amended to limit the claim to a practical application. In other words, if the specification discloses a practical application of a section 101 judicial exception, but the claim is broader than the disclosure such that it does not require a practical application, then the claim must be rejected.” and “The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a 35 U.S.C. 101 judicial exception, in that the process claim must set forth a practical application of that judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had “no substantial practical application.”).”

Specifically, the claimed subject matter is broader than the disclosure such that it does not require a practical application to produce a useful, concrete, and tangible result. More

specifically, the claimed subject matter provides for allocating the defined set of components to computer hardware resources. However, the recited “computer hardware resources” may not have anything to do with the recited “computing resources” and they could be, for example, printers, cables, etc., which when the defined set of components is allocated does not appear to have a practical application providing a useful, concrete, and tangible result.

### ***Recommendations***

9. Claim 9 recites the limitation, “data and control partitions” in lines 13-14 of the claim. For clarification purposes, the Examiner suggests that the “data and control partitions” be replaced with “data and code partitions”.

### ***Applicant's Arguments***

10. Applicant argues the following:

**10-1. Objection to the Specification**

(1) “Applicant respectfully submits that a person having ordinary skill in the art would appreciate that the amendments to the specification correct typographical errors and do not introduce new matter.” (page 6, paragraph 3, Amendment)

**10-2. §112 Rejection of the Claims**

(2) “Applicant has amended claim 1 (and claim 9) so as to clarify that tasks in couplings are preallocated.” (page 7, paragraph 1, Amendment)

(3) “Applicant has amended claim 14 such that each element of the group are now used in determining a data coupling strength.” (page 7, paragraph 3, Amendment)

(4) “Applicant has amended claim 15 such that it now depends from pending claim 9.”  
(page 7, paragraph 4, Amendment)

**10-3. §101 Rejection of the Claims**

(5) “Applicant respectfully submits that allocating components to hardware resources is a real world application that clearly produces a useful, concrete and tangible result of the method recited in claims 1-3 and 5-8.” (page 7, paragraph 6, Amendment)

***Response to Arguments***

**11.** Applicant’s arguments have been fully considered.

**11-1.** Applicant’s argument (1) is not persuasive. The amendment to Table 6 at page 21 of the specification filed on November 24, 2006, does not appear to have support in the original disclosure including the provisional application. Furthermore, Applicant has argued at page 9, paragraph 4, of the amendment filed on November 30, 2005, “Applicant respectfully submits that the timing strength calculation is adequately described in the specification. As noted on page 21, the various endpoints at the extremes are assigned strengths of 1-10. Thus according to table 6, when the timing is at or near the minimum endpoint, the timing strength is 10. When the timing is at or near the maximum endpoint, the timing strength is 1. Thus Table 6, when read in conjunction with the specification, adequately describes and enables pending claims 5-7 and 13-15.” In other words, Applicant’s argument (1) is not persuasive because Applicant specifically denies typographical errors and asserts, “Table 6, when read in conjunction with the specification, adequately describes and enables pending claims 5-7 and 13-15”.

**11-2.** Applicant's arguments (2), (3), and (4) are persuasive. The rejections of claims 1-3, 5-11, and 13-16 under 35 U.S.C. 112, in Office Action dated November 7, 2007, have been withdrawn. However, the amended claims 1 and 9 specifically recite "preallocating *tasks* in each coupling". In other words, only "tasks" in each coupling are preallocated. Therefore, there is insufficient antecedent basis for the limitation "the preallocated data and code partitions" in claims 1 and 9.

**11-3.** Applicant's argument (5) is not persuasive. The claimed subject matter is broader than the disclosure such that it does not require a practical application to produce a useful, concrete, and tangible result. Specifically, the claimed subject matter provides for allocating the defined set of components to computer hardware resources. However, the recited "computer *hardware* resources" may not have anything to do with the recited "*computing* resources" and they could be, for example, printers, cables, etc., which when the defined set of components is allocated does not appear to have a practical application providing a useful, concrete, and tangible result.

### ***Conclusion***

**12.** Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on



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the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**13.** Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Herng-der Day whose telephone number is (571) 272-3777. The Examiner can normally be reached on 9:00 - 17:30.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (571) 272-2100.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Kamini S. Shah can be reached on (571) 272-2279. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kamini S Shah/

Supervisory Patent Examiner, Art Unit 2128

/Herng-der Day/  
Examiner, Art Unit 2128

July 3, 2008